

REMARKS

Claims 1-39 are cancelled. **Claims 41, 44-45, 47, 51, 53, 56-57, 59, and 63 are subject to an affirmed rejection by the BPAI.** Although all of the appealed claims are listed in the listing of claims above, only the claims rejected under new grounds are available for further prosecution here.

Claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 stand rejected under new grounds of rejection including newly cited art, under 37 CFR 41.50(b)(1) by the Board of Patent Appeals and Interferences. The rejection is based on a combination of Motoyama US Patent 5,353,388, Hanson et al. US Patent 5,956,736, and "Working With Microsoft Word 6.0: Part II: The Art Of Page Design", At The Office, Vol. 6, Issue 5 (May 1995). This rejection is traversed

Independent claims 40 and 52 have been amended and claims 42-43, 46, 48-50 depend from claim 40 and claims 54-55, 58, and 60-62 depend from claim 52.

Independent Claim 40 will be addressed as representative of independent claim 52. In the field of digital printing, printer operators often receive documents having a variety of different characteristics, such that different portions of the documents often need to be printed by different printing devices. For example, a document may include sections having only black and white text and other sections having color images. The printer operator may need to print the sections having only black and white text with black and white printers and the sections having color images with color printers. It is therefore desirable that the printer operator have the ability to designate on which printing devices the various pages of the composite document should be printed without compromising the integrity of the original electronic version. It is further desirable that the printer operator has the ability to group the pages destined for a specific printing device and print them together without printing pages associated with other printing devices. Since the pages destined for the same printing device may be non-consecutive, it is desirable that the printer operator be able to designate a single group of images which includes both consecutive and non-consecutive pages that can be single pages or subgroups of pages.

The present invention addresses these problems by inserting group identifiers into electronic representations of the documents. The group identifiers establish one or more groups of pages each group of which can include consecutive and

non-consecutive pages that can be single pages or sub-groups of pages and are used by software to allow a printer operator to selectively print these page groups with different printers. Claim 40 defines a method of operating a print system to print an electronically formatted document having a plurality of images. The method includes running a Print Document Management System (PDMS) program on a computer which receives the document into the Print Document Management System program. The method also includes displaying in the PDMS a Graphical User Interface ("GUI") which permits a print operator to assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document, wherein a single group of pages can include both consecutive and non-consecutive pages that can be single pages or sub-groups of pages. Additionally, the method includes instructing the computer to send one or more of the groups of pages of the amended document to an output data stream for printing.

In its Decision on Appeal, the Board of Patent Appeals and Interferences has admitted that "The combination of Motoyama and Hanson does not teach using a GUI to establish groups of pages and thus the combination does not teach using a GUI in the creating step." The Board then cites "Working with Microsoft Word 6.0: Part II: The Art of Page Design, At the Office", Vol. 6, Issue 5 (May 1995) (hereafter "MS Word") and states "However, MS Word teaches that it is well known in the art at the time of the invention was made to provide a GUI that permits a user to edit an existing document to define different portions of a document (e. g., one or more paragraphs) as sections. (FF9)" Even assuming this is true, MS Word only teaches dividing a document into sections of consecutive pages. MS Word states:

"Creating Sections

The text in multiple – column documents flows from the bottom of one column to the top of the next –like the columns in a newspaper. By using **sections** you can change the number of columns in a document.

To divide your document into sections, position the insertion point where you want to begin a section. Choose Break from the Insert menu. Under the area called Section Breaks, choose the option that describes where you want the next section to begin: Odd Page, Even Page, Next Page, and Continuous. With Next Page, Word breaks the page at the section break and begins a new page. With Continuous, Word notes the new section but keeps it on the same page. With Odd Page, Word begins the new section on the next odd-numbered page. And with Even Page, Word begins the new section on the next even-numbered page."

The sections of MS Word do not correspond to the groups in Claim 40, in which group identifiers establish groups of pages, in which a single group of pages can have both consecutive and non-consecutive pages that can be single pages and sub-groups of

consecutive pages. In MS Word, the Graphical User Interface (“GUI”) is used to create sections. This is unlike Claim 40, in which the GUI permits a print operator to assign group identifiers into the document to establish the groups of pages. In MS Word, the GUI is not disclosed as permitting an operator to assign such identifiers into a document. In Claim 40, the GUI permits a print operator to assign group identifiers and instruct the computer to send one or more of the groups established by the group identifiers to an output data stream for printing. The MS Word reference lacks such identifiers or printable groups. In the above-quoted portion of MS Word, each section is unique and not associated with the next section and there is no single identifier that identifies all of the marked sections as a single group that can be printed on a printer all at once. The printer operator would have to go through the entire document section by section to send each section to a specified printer. Such is not the case with the claimed invention, where a single identifier is used for all pages to be sent to a specified printer. The common identifier of the present invention identifies a group of pages that can be consecutive pages and non-consecutive pages, and that can be single pages or sub-groups of consecutive pages. No such capability is taught by MS Word. As an example, if a printer operator is presented with a ten page document, and wants to send pages 1-3, 5 and 7-10 to a designated printer, using MS Word, the operator could section consecutive pages 1-3 as one group of pages and consecutive pages 7-10 as another distinct group of pages. The single non-consecutive page 5 would not be sectioned. Thus, using MS Word, the printer operator would have to send each section and page 5 separately to the printer since there is no capability in MS Word of attaching a single identifier to the first section including pages 1-3, to non-consecutive page 5 and to the second section including pages 7-10. This problem is solved by the claimed invention by allowing a printer operator to attach a single identifier to each of the first and second sections and to single page 5.

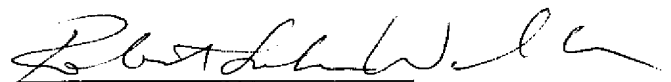
It is submitted that Claims 40, 42-43, 46, 48-50, 52, 54-55, 58, and 60-62 are nonobvious over Motoyama, Hanson, and MS Word and should be allowed.

Since Claims 41, 44-45, 47, 51, 53, 56-57, 59, and 63 which had an affirmed rejection by the BPAI are dependent from allowable Claims 40 and 52, it is submitted that these claims should also be allowed. As stated in MPEP 1214.01; “Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution.”

It is believed that these changes now make the claims clear and definite and, if there are any problems with these changes, Applicants' attorney would appreciate a telephone call.

In view of the foregoing, it is believed none of the references, taken singly or in combination, disclose the claimed invention. Accordingly, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Robert Luke Walker", written over a horizontal line.

Attorney for Applicant(s)
Registration No. 30,700

Robert Luke Walker/amb
Rochester, NY 14650
Telephone: (585) 588-2739
Facsimile: (585) 477-1148